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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/785,053      | 02/25/2004  | Naoki Nimura         | 826.1923            | 8543             |

  

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| 21171                      | 7590 | 01/15/2008 |
| STAAS & HALSEY LLP         |      |            |
| SUITE 700                  |      |            |
| 1201 NEW YORK AVENUE, N.W. |      |            |
| WASHINGTON, DC 20005       |      |            |

  

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| EXAMINER            |  |
| TOLENTINO, RODERICK |  |

  

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| ART UNIT | PAPER NUMBER |
| 2134     |              |

  

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| MAIL DATE  | DELIVERY MODE |
| 01/15/2008 | PAPER         |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                       |                                      |  |
|------------------------------|---------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/785,053  | <b>Applicant(s)</b><br>NIMURA ET AL. |  |
|                              | <b>Examiner</b><br>Roderick Tolentino | <b>Art Unit</b><br>2134              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2007.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,6,8,9,11,12,14 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6,8,9,11,12,14 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2004 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>08/31/2007</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1, 2, 5, 6, 8, 9, 11, 12, 14 and 20 are pending claims 3, 4, 7, 10, 13 and 15 – 19 are cancelled by applicant.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1, 2, 5, 6, 8 and 9 have been considered but are moot in view of the new ground(s) of rejection as necessitated by amendment made by applicant on 10/26/2007.

### ***Claim Objections***

3. Claim 11 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.
4. As per claim 11, the applicant's claim uses the phrase "can be used," however in the event of the latter part of the "can be used" statement (i.e. the situation where the limitation can not be user), the claim will not do anything to the invention thus making the claim have no further limiting qualities.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 5, 6, 8, 9, 11 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schipper et al. U.S. Patent No. (5,987,136) in view of Bolosky et al. U.S. Patent No. (7,043,637).

7. Invention is being interpreted to be a key created by some piece of data followed by standard public key and standard hash algorithms. The invention is rejected using the Schipper and Bolosky ruling and in light of KSR rules.

8. As per claims 1, 2, 5, 6, 8 and 9, Schipper teaches obtaining a position in which a file can be opened as current position information from a position detecting device or as position information from an input device, and obtaining data indicating a number of significant digits of the position information used for encryption or decryption of the file from the input device (Schipper, Col. 13 Lines 53 – 67, Key based on position information), encrypting a-the file by using, as a key, data having high-order digits corresponding to the number of significant digits of the position information obtained from the position information and the data indicating the number of significant digits (Schipper, Col. 8 Lines 50 – 67, key encrypts and decrypts information), but fails to teach further generating a first digest which is data resulting from a hash operation performed on the encrypted file, and generating public key encryption data by

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encrypting, using a public key, the data indicating the number of significant digits, the file encrypted using the position information as a key, and the first digest and generating a second digest by performing a hash operation on the .generated public key encryption data, and generating data to be provided by adding the second digest to the public key encryption data. However in an analogous art Bolosky teaches teach further generating a first digest which is data resulting from a hash operation performed on the encrypted file (Bolosky, Col. 22 Lines 13 – 23, computes hash of encrypted file) and generating public key encryption data by encrypting, using a public key, the data indicating the number of significant digits, the file encrypted using the position information as a key, and the first digest and generating a second digest by performing a hash operation on the .generated public key encryption data, and generating data to be provided by adding the second digest to the public key encryption data (Bolosky, Col. 13 Lines 40 – 48, Hash of a public key).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Bolosky's on-disk file format for a serverless distributed file system with Schipper's image authentication patterning because it offers the advantage of insuring that the files are stored and accessed in a secure way that prevents access by non-authorized users (Bolosky, Col. 1 Lines 55 – 60).

9. As per claim 11, Schipper as modified teaches wherein said encrypting includes encrypting the program with the position information which specifies a position in which the program can be used (Schipper, Col. 8 Lines 50 – 59, encryption and decryption based on position information).

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10. As per claim 20, Schipper as modified teaches a program for reading map data from a storage medium on which is recorded map data encrypted with position information which specifies a position in which the map data can be used, the program including allowing the map data to be decrypted only if position information detected by a position detecting device and the position information used to encrypt the map data match (Schipper, Col. 8 Lines 50 – 59, encryption and decryption based on position information).

11. Claims 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schipper et al. U.S. Patent No. (5,987,136) in view of Bolosky et al. U.S. Patent No. (7,043,637) and in further view of Bel et al. U.S. Patent No. (7,124,304).

12. As per claim 12, Schipper fails to teach said encrypting includes encrypting the program with the position information and a license key given to a user. However, in an analogous art Bel teaches said encrypting includes encrypting the program with the position information and a license key given to a user (Bel, Col. 2 Lines 49 – 59, encrypts file with License key).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Bel's receiving device for securely storing a content item and a playback device with Schipper's image authentication patterning because it offers the advantage of securely storing and protecting content from unauthorized parties (Bel, Col. 1 Lines 5 – 11).

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13. As per claim 14, Schipper teaches encrypted using position information and decrypting the encrypted program with position information (Schipper, Col. 8 Lines 50 – 59, encryption and decryption based on position information) but fails to teach a program encrypted using a license key, and decrypting the encrypted program the license key (Bel, Claim 11, decrypts with license key).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Bel's receiving device for securely storing a content item and a playback device with Schipper's image authentication patterning because it offers the advantage of securely storing and protecting content from unauthorized parties (Bel, Col. 1 Lines 5 – 11).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roderick Tolentino whose telephone number is (571) 272-2661. The examiner can normally be reached on Monday - Friday 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on (571) 272-3811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Roderick Tolentino

Roderick Tolentino  
Examiner  
Art Unit 2134

  
KAMBIZ ZAND  
SUPERVISORY PATENT EXAMINER